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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,789	03/13/2000	Karim Asani	99951.1	6310

7590 09/28/2005

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New York, NY 10005

EXAMINER
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COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/523,789

Applicant(s)

ASANI, KARIM

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-12 are pending in this communication filed 2/18/05 (not 12/29/05 as on the first page of the Response) entered as response to Non-Final Action.
2. The Replacement sheets of drawing figures 5A and 6 filed 02/18/05 have been reviewed and contain errors as set forth here below.
3. As a preliminary matter, Applicant is respectfully requested to note that the Examiner assigned for prosecution of this application has changed. All future correspondence should be addressed to E. Colbert, Art Unit 3624.

### ***Specification***

4. The Specification is objected to because of the following informalities: Page 9, "Brief Description of Drawings" does not mention Figure 5A and Figure 5B but simply has Fig. 5. Applicant's description should recite "Fig. 5A and Fig. 5B are a block diagram showing the process flow diagram" or Fig. 5A is a block diagram showing the process flow diagram" and "Fig. 5B is a block diagram showing the process flow diagram".

Figures 2-4 in the Specification have different labels for the figure elements that are not in agreement with the drawing element labels. For example, figure 2 in the Specification references "merchant's transaction information 140, merchant's and client's information 150, and "smart" processing 160 database respectively. The ... client's I/O registration information 110, client's password and validation data 120, and the client's biometrics information 130 respectively." The figure 2 elements in the drawing figure are labeled as follows: "MERCHANT TRANSACTION DATABASE 140,

MERCHANT AND CLIENT FINANCIAL INFORMATION DATABASE 150, I/O DEVICE REGISTRATION DATABASE 110, SECURE PASSWORD AND VALIDATION DATABASE 120, AND BIOMETRICS DATABASE 130." Figures 3, 4, 5A, 5B, and 6 have a similar problem.

Figure 3 has "O/I DEVICE 225" and the drawing has 'I/O DEVICE 215" and "INPUT DEVICE 225"; "VIDEO MONITOR" is labeled "235" in the drawing and "240" in the Specification; element "245" is labeled as "RAM" in the drawing; "ROM" is labeled "250" in the drawing; and "220" is labeled "COMM. PORT" in the drawing and not "communication link 220" as referenced in the Specification.

Figure 4 in the Specification does not mention elements "POS NETWORK 280; MERCHANT 300; or the other elements "280" and "100" in the drawing figure.

Figure 5 does not distinguish between the elements of Figure 5A and Figure 5B in the Specification. The elements in the Specification are not labeled in agreement with the drawing element labels and the elements re labeled different numbers in the drawing figure(s) than in the Specification. Elements 410 and 420 are not found in the drawing figure and steps 690" and "730" are missing from figures 5A and 5B.

Figure 6 does not mention or describe element "1040" in the Specification and element "100" is referenced as "step 1035" and "100".

There are only some of the errors found in the Specification. Applicants' are respectfully requested to review the Specification for other errors where the drawing figure and the reference label and the element number do not agree.

A substitute specification required pursuant to 37 CFR 1.125(a) because of the above mentioned errors.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "100" and "1035" have both been used to designate "FINANCIAL INSTITUTION CENTRAL CLEARINGHOUSE". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "235" has been used to designate both "VIDEO DRIVER" and "VIDEO MONITOR" in figure 3 and reference character "280" has been used to designate both "POS NETWORK" and simply "280" in figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 recites the limitation "secure password" in line 18 and "password" throughout the claim. Claim 7 recites "secure parameter" in the preamble and "secure password" in the body of the claim. Claim 12 recites "secret password" in lines 4-6 and

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in line 7 recites "password". There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 12 is rejected under 35 U.S.C. 101 as non-statutory. The body of the claim as presented does not claim a technological bases. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 USC 101. In contrast, a claim that includes in the body of the claim at least one/structural/functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (BD. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

The body of the claim hints at technology. For example receiving the secret password; calculating the amount of funds having the password and outputting the funds appear to have a technological basis. However, receiving a secret password could be by word of mouth or on paper, calculating the amount of funds having the password could be performed with a pencil and paper, and the outputting of the funds could be done by a person. Applicant needs to have a machine or device to perform the steps in the body of claim 12.

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A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### **Inquiries**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

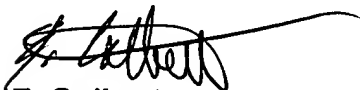


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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'E. Colbert', with a long horizontal flourish extending to the right.

**E. Colbert**

**Primary Patent Examiner**

September 24, 2005